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Supreme Court of the United States

October Term, 1975

No. _____

GEORGE DICKSTEIN, SPORTS PRODUCTS CORPORATION,

Petitioners,

vs.

SEVENTY CORPORATION, PETER BOYKO and GRANTHAM, INC.,

Respondents.

PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals
For the Sixth Circuit

George Dickstein, Sports Products Corporation petition the Court to issue its writ of certiorari to the United States Court of Appeals for the Sixth Circuit to review the judgment entered by that court in Causes No. 75-1121 and 75-1122 on its docket, and in support thereof says:

OPINIONS BELOW

The opinion of the District Court (by Judge Robert Krupansky in the Northern District of Ohio, Eastern Division) is not reported but appears in the Appendix hereto at page 1A; the opinion of the United States Court of Appeals for the Sixth Circuit (by Judge Phillip, concurred in by Judges McCree and Lively) is not reported by appears in th e Appendix hereto at page 21A.

JURISDICTION

The judgment sought to be reviewed is dated and was entered August 25, 1975; rehearing was denied October 2, 1975. This Court has jurisdiction to review pursuant to 28 U.S.C. 1254(1) and 2101(c).

QUESTIONS PRESENTED

Presented to this Court for review is the decision in this case from the Sixth Circuit Court of Appeals that is in conflict with a previous decision of this Court, and previous decisions of the Fifth, Seventh and Tenth Circuits Courts of Appeals on the same principal issue.[1]

THE QUESTIONS PRESENTED FOR REVIEW ARE:

(1) In a patent case, when asserting patent invalidity as being directed to Obvious Subject Matter under

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1. 5th Circuit; Beyond Reasonable Doubt.

Stamicarbon N.V. v. Escambia Chemical Corporation, 300 F. Supp. 1209, *aff'd*, 430 F.2d 920 (5th Cir. 1970); *Hunt Tool Co. v. Lawrence* 242 F.2d 347 (5th Cir. 1957); *Cameron Iron Works v. Stekoll*, 242 F.2d 17 (5th Cir. 1957); *Foster Cathead Co. v. Hasha*, 382 F.2d 761 (5th Cir. 1967), *cert. denied*, 390 U.S. 906, 88 S. Ct. 819, 19 L. Ed. 2d 872 (1947).

Supreme Court, 7th and 10th Circuits; Clear and Convincing.

Radio Corporation of America et al. v. Radio Engr. Lab. Inc., 293 U.S. 1, 21 USPQ 353 (1934); *Century Industries, Inc. v. Wieboldt Stores, Inc.*, 263 F.2d 934 (7th Cir. 1959), *cert. denied* 359 U.S. 1010, 79 S. Ct. 1149, 3 L. Ed. 2d 1036 (1959); *Consolidated Electro-dynamics Corp. v. Midwestern Instruments, Inc.*, 260 F.2d 811 (10th Cir. 1958).

2nd Circuit, Court of Customs and Patent Appeals; Preponderance of Evidence.

Thomson Industries, Inc. v. Nippon Thompson Co., 298 F. Supp. 466 (E.D.N.Y. 1968); *Application of Lurelle Guild*, 204 F.2d 700, 40 CCPA 996 (1954).

35 U.S.C. 103, WHAT is the standard or quantum of proof required to overturn the presumption of Validity afforded a U.S. patent by 35 U.S.C. 282?

In accordance with this Court's Rule 53 two additional questions, particular to this case, are also presented for review:

(2) Whether a Court of Appeals in its efforts to follow this Court's mandate in the *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684, 695 (1965) case, may, in the absence of any record evidence in the trial Court from "one skilled in the art", *substitute itself* into the record as the "one skilled in the art" in its efforts to find a United States Patent invalid under 35 U.S.C. 103;

(3) And, may a Court of Appeals properly draw the inference that a Patent Examiner did not properly perform his duty under the law 35 U.S.C. merely because he, the Examiner, allows a patent application "as filed" in accordance with 35 U.S.C. 131.

CONSTITUTIONAL PROVISION AND STATUTES

The Constitutional and statutory provisions relevant to this case are:

Constitution, Article I, Section VII

"The Congress shall have power * * * To promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries * * *."

35 U.S.C. 103, Conditions for Patentability; Non-Obvious Subject Matter

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *" July 19, 1952, c. 950 § 1, 66 Stat. 798.

35 U.S.C. 282, Presumption of Validity: Defenses

"A patent *shall be presumed valid.* The burden of establishing invalidity of a patent shall rest on a party asserting it. * * *" July 19, 1952, c. 950 § 1, 66 Stat. 812.

35 U.S.C. 131, Examination of Application

"The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor." July 19, 1952, c. 950 § 1, 66 Stat. 801.

STATEMENT OF THE CASE

The plaintiff George Dickstein, owner of U.S. patent 3,711,864, and Sports Products Corporation, of which Dickstein is president, brought this action for infringement against defendants Seventy Corporation, Grantham, Inc. and Peter Boyko.

The District Court held the patent Valid and Infringed, and stated with respect to the Validity of said patent:

". . . the Court presumes the patent here in issue to be valid and in the absence of *clear and convincing evidence* to the contrary presumes further that the Patent Office acted correctly in issuing the patent."

"This presumption of validity is merely a rule of evidence which places the burden upon one who disputes the validity of a patent to come forward with *clear and convincing evidence* that the Patent Office acted erroneously in issuing the later patent. . . ."

". . . the Court concludes that the defendants have failed to prove their affirmative defense of obviousness by clear and convincing evidence. . . ."

"Accordingly, the defendants having failed to overcome the presumption of validity attached to the patent by clear and convincing evidence, and upon the record in its entirety, the Court concludes that patent '864 is valid."

The Court of Appeals (CA6) reversed the District Court and held the patent invalid under 35 U.S.C. 103, stating:

"The District Court required the defendants to 'prove their affirmative defense of obviousness by clear and convincing evidence.'. . . .

". . . We find no reported decision in this Circuit determining the quantum of proof required on the issue of obviousness."

"We are therefore of the opinion that in this case, and *in the usual patent case* in which validity is proved with similar evidence, a *preponderance of evidence* is sufficient to establish invalidity. . . ."

With respect to the two additional questions 2 and 3 (*supra*) particular to this case, the Appeals Court held:

"(2) . . . A *person of ordinary skill* in the art would be able to use this (prior art) disclosure . . . to produce a device as claimed."

"(3) . . . the record supports the inference that the patent application received only a cursory examination in the Patent Office. The first patent application was allowed on the first office action by the Patent Office, ... The continuation was also allowed on the first office action. It does not appear that the Patent Office supplied substantive comments of *any nature*, in either application, concerning the patentability or unpatentability of the claims."

Decision of Court of Appeals Is in Conflict With Prior Decision of This Court, and Courts of Appeals of the Fifth, Seventh and Tenth Circuits

In 1934 the United States Supreme Court in the case of:

Radio Corporation of America et al. v. Radio Engineering Laboratories, Inc., 293 U.S. 1, 21 USPQ 353 (1934)

spoke to this issue of "presumption of validity" of a United States Patent when Mr. Justice Cardozo speaking for the Court said:

. . . A patent regularly issued, and even more obviously a patent issued after a hearing of all the rival claimants, is presumed to be valid until the *presumption has been overcome by convincing evidence of error*. . . .

". . . that one otherwise an infringer who assails the validity of a patent fair upon its face bears a heavy burden of persuasion, and fails unless his evidence has *more than a dubious preponderance*."

In 1970, in the case of *Stamicarbon N.V. v. Escambia Chem. Corp.*, 300 F. Supp. 1209, *aff'd*, 430 F.2d 920 (5th Circuit); Circuit Judge Clark characterized the Federal Circuits as being in *"a morass of conflict"* with respect to this issue and cited numerous cases reported in the 5th, 7th and 10th Circuits as well as the United States Court of Customs and Patent Appeals which indicates that the several Circuits have, in fact, adopted "three (3) standards of proof", i.e., beyond a reasonable doubt (5th Circuit); clear and convincing (7th, 10th Circuits); and preponderance (2nd, CCPA) (See fn. 1, p. 2).

This "Morass of Conflict" As Characterized by Judge Clark Remains to This Day

The standard of evidence on the issue of OBVIOUSNESS (35 U.S.C. 103) that is required to overcome the Statutory Presumption of Validity afforded by 35 U.S.C. 282 is a fundamental basic concept of United States Patent Law, and in this day of international participation in this nation's technological development and commerce, the adoption of a *uniform standard* throughout the United States on this basic concept is a fundamental requisite to the welfare of the United States as well as to the world community in order to assure that the mandate handed to us by our forefathers in the United States Constitution, Article 1, Section 8,

"to promote the Progress of Science and Useful Arts"

will be uniformly protected and continued throughout the United States.

In *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684 (1965) this Court issued its mandate on the question of Obiousness under 35 U.S.C. 103, and established a clear and concise four (4) step factual inquiry which this Court

intended to be uniformly applicable throughout the United States to determine the presence or absence of invention under this Federal Statute.

Because the 5th, 7th and 10th Circuit Courts of Appeals and now the 6th Circuit herein have *adopted three (3) standards* of evidence to overcome the presumption of validity under 35 U.S.C. 282, the factual inquiry required in this Court's mandate in the *Graham* case under 35 U.S.C. 103 is *not* now uniformly applicable throughout the various Federal Circuits as was clearly intended by this Court.

The Court of Appeals also erred in holding that a person of ordinary skill would be able to use the disclosures of several of the prior art devices to produce a device as claimed in the Dickstein patent.

In the District Court there is no record testimony of "ONE SKILLED IN THE ART" to show the relationship of the prior art patents and sample devices to the Dickstein invention.

The defendants merely submitted these alleged prior art references into the record below and *did not* elicit any testimony from "ONE SKILLED IN THE ART" as to how it would be obvious to use the teachings of said prior art to produce a device as claimed in Dickstein's patent.

The Court of Appeals has *injected itself* into this record as *the* "ONE SKILLED IN THE ART" and has ruled that the invention of the Dickstein patent is invalid under 35 U.S.C. 103.

The Court of Appeals also erred in ruling that the Patent Office Record indicates that the Dickstein patent application received only a *cursory* examination in the Patent Office.

The file wrapper of the Dickstein patent shows that the applications, original and continuation, were each allowed as filed. There is absolutely nothing in the file wrapper of either application to support the statement that a mere "cursory" examination was made by the Patent Examiner. To the contrary, the Official Record clearly shows that the Patent Examiner made a thorough and complete search of the relevant prior art in the records of the Patent Office, in full compliance with 35 U.S.C. 131.

He then issued his Official Report to the inventor identifying the prior art which he had examined and considered in connection with the Dickstein invention, and indicated that said invention was patentable.

REASONS FOR GRANT OF WRIT

This Court should take this case:

1. To establish a uniform standard of evidence in the Federal Patent Law which is equally applicable throughout the United States to overcome the statutory Presumption of Validity afforded a patent under 35 U.S.C. 282.

2. To determine whether a Court of Appeals may, in the absence of any record evidence in the trial court, *inject itself* into the record as one "skilled in the art" in determining Obviousness under 35 U.S.C. 103.

3. To determine whether under 35 U.S.C. 131 a Patent Examiner may allow a patent application as filed without an inference being drawn that such action represents a "cursory examination."

CONCLUSION

The writ should issue.

Respectfully submitted,

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APPENDIX

MEMORANDUM, OPINION AND ORDER OF THE DISTRICT COURT

(Filed November 1, 1974)

Civil Action No. C73-79

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

GEORGE DICKSTEIN,
Plaintiff,

SPORTS PRODUCTS CORPORATION,
Party Adverse to Defendant,

VS.

SEVENTY CORPORATION,
GRANTHAM, INC.,
PETER BOYKO,
Defendants.

MEMORANDUM, OPINION AND ORDER

KRUPANSKY, *J.*

This is an action initiated by the plaintiffs George Dickstein ("Dickstein") and Sports Products Corporation ("Products") against the defendants Seventy Corporation ("Seventy"), Grantham, Inc. ("Grantham"), and Peter Boyko ("Boyko") for infringement of United States Patent Number 3,711,864 (" '864") duly, lawfully and regularly issued by the United States Patent Office on Janu-

ary 23, 1973, pursuant to application Number 194,249 filed November 1, 1971, a continuation-in-part of application Number 77,516 filed October 2, 1970, and later abandoned.

The patent is issued in the name of owner-inventor George Dickstein.

This action was tried to the Court upon the evidence and exhibits admitted at trial.

The parties have stipulated the jurisdiction and venue of the Court arising pursuant to the patent and declaratory judgment laws of the United States.

The parties are in accord that infringement, if any, is of claim Number 1 of said patent by reasons of defendants' manufacture and sale of plaintiffs' Exhibits 7 and 9, representative examples of defendants' product.

Defendants have affirmatively asserted invalidity of claims 1, 2, and 3 of the patent which read as follows:

> 1. A protective helmet of hard thermoplastic synthetic resin and a flexible protective harness inside thereof, said helmet having a crown portion, said harness having a sweatband strap extending around the inside of said crown at approximately the height of the temples of the wearer, said harness including a plurality of integral projecting portions extending upwardly and inwardly from said strap toward the center of said crown, the inner end of each of said projecting portions having an integral outwardly protruding generally cylindrical hollow cup opening inwardly, there being a through opening in the bottom of each said cup of a diameter smaller than the inside diameter of said cup, there being a plurality of inwardly extending studs integral with said crown, each

of said studs being so positioned and of a size to pass through one of said through openings of one of said cups when said harness is snugly assembled inside of said helmet, and the inner end of each of said studs being expanded adjacent the inside of said cup bottom to a size larger than its associated through opening, whereby each of said harness projecting portions is firmly held in said helmet and each of said cups protects the head of the wearer against injury from its associated stud.

2. A protective helmet as defined in claim 1, including a protective padding strip between said strap and said helmet and secured to the outer face of said strap.

3. A protective helmet of hard thermoplastic synthetic resin and a flexible protective harness inside thereof, said helmet having a crown portion, said harness having a sweatband strap extending around the inside of said crown at approximately the height of the temples of the wearer, said harness including a plurality of integral projecting portions extending upwardly and inwardly from said strap toward the center of said crown, the inner end of each of said projecting portions having an integral outwardly protruding generally cylindrical hollow cup opening inwardly, there being a through opening in the bottom of each said cup of a diameter smaller than the inside diameter of said cup, there being a plurality of inwardly extending studs integral with said crown, each of said studs being so positioned and of a size to pass with friction through one of said through openings of one of said cups when said harness is snugly assembled inside of said helmet, each stud being positioned on said crown portion to lie at an angle to the vertical

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when the helmet is on the head of the wearer so that the associated cup will not slip off its stud, and the inner end of each of said studs stopping short of the planar edge of its associated cup, whereby each of said harness projecting portions is firmly held in said helmet and each of said cups protects the head of the wearer against injury from its associated stud.

Defendants' asserted claims of invalidity are:

1. The difference between the subject matter of the alleged invention covered by the '864 patent and the prior art is such that the subject matter as a whole would have been obvious, at the time of the invention, to a person having ordinary skill in the art to which the subject matter pertains;

2. Patent '864 is for a combination of old and unpatentable elements within the skill of the art contrary to Title 35 §§102 and 103 of the United States Code;

3. The alleged invention of patent '864 was in public use in this country more than one year prior to the date of plaintiff's patent application contrary to the provisions of Title 35 §102(b) of the United States Code;

4. The plaintiff Dickstein did not himself invent the subject matter sought to be patented, but he derived said subject matter from Boyko;

5. The patent application did not contain written descriptions of the alleged invention, and of the manner and process of using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains to make and use it, nor does it set forth the best modes con-

templated by the plaintiff of carrying out of his alleged invention, and it fails to particularly point out and distinctly claim the subject matter which plaintiff regarded as his invention contrary to Title 35 §112 U.S.C.;

6. The patent is unenforceable because plaintiff withheld material facts from the Patent Office during the prosecution of the application which issued as the patent.

The defendants in their counterclaim for declaratory judgment seek to declare the patent invalid and pray for a finding of no infringement.

The law is clear that a patent once issued is presumed valid, and a heavy burden of proof rests upon the party asserting invalidity. *Westwood Chemical, Inc. v. Owens-Corning Fiberglas Corp.*, 445 F.2d 911 (6th Cir. 1971); *Ever-Wear, Inc. v. Wieboldt Stores, Inc.*, 427 F.2d 373 (7th Cir. 1970); 35 U.S.C. §282. However, a patent to be valid must meet all the requisite statutory requirements of 35 U.S.C. §101, and an invention which does not combine the three essential elements of novelty, utility and nonobviousness should not be awarded privileged monopolistic status. *Monroe Auto Equipment Company v. Heckethron Manufacturing & Supply Co.*, 332 F.2d 406, 409-410 (6th Cir. 1964); *Zero Manufacturing Company v. Mississippi Milk Producers Association*, 358 F.2d 853, 855 (5th Cir. 1966).

The burden of proof of the affirmative defenses directed to the invalidity of the patent herein having been asserted by the defendants places such burden as to one or more of these assertions upon the defendants by clear and convincing evidence.

Thus, in considering the defenses of invalidity, the Court presumes the patent here in issue to be valid and in the absence of clear and convincing evidence to the contrary presumes further that the Patent Office acted correctly in issuing the patent. *King-Seeley Thermos Co. v. Refrigerated Dispensers, Inc.*, 354 F.2d 533 (10th Cir. 1965); *Devex Corp. v. General Motors Corp.*, 321 F.2d 234 (7th Cir. 1963), *cert. denied*, 375 U.S. 971, 84 S.Ct. 490 (1964); *Neff Instrument Corp. v. Cohu Electronics, Inc.*, 298 F.2d 82 (9th Cir. 1961); *Warner & Swasey Co. v. Universal Marion Corp.*, 237 F.Supp. 719 (D. Colo. 1964), *aff'd*, 354 F.2d 541 (10th Cir. 1965), *cert. denied*, 384 U.S. 927, 86 S.Ct. 1444 (1966); *Elgen Mfg. Co. v. Ventfabrics, Inc.*, 207 F.Supp. 240 (N.D. Ill. 1962), *aff'd*, 314 F.2d 440 (7th Cir. 1963); *Universal Incorporated v. Ray Mfg. Corp.*, 195 F.Supp. 241 (M.D. N.C. 1961), *aff'd* 301 F.2d 140 (4th Cir. 1962).

Clear and convincing evidence is defined as:

> . . . that measure or degree of proof which will produce in the mind of the trier of the facts a firm belief or conviction as to the allegations sought to be established. It is intermediate, being more than a preponderance, but less than that required to establish guilt upon a reasonable doubt as required in criminal cases, and it does not mean clear and unequivocal. *Hobson v. Eaton*, 399 F.2d 781 (6th Cir. 1968) *cert. denied* 394 U.S. 1928 (1968); *Cross v. Ledford*, 161 O. State 469, 120 N.E. 2d 118.

The test of obviousness to be applied in considering the validity of a patent is to determine if "the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

ordinary skill in the art to which the subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made." 35 U.S.C. §103.

As an indicia of obviousness or nonobviousness, consideration must be given to such factual inquiries as:

1. scope and content of the prior art;
2. differences between the prior art and the claims at issue;
3. the level of ordinary skill in the pertinent art.

Such secondary considerations as commercial success, or lack thereof; long felt but unresolved needs; failure of others and other similar facts may also be utilized by the Court to reflect light upon the circumstances surrounding the origin of the subject matter sought to be patented.

Although inquiry into these secondary considerations is relevant to the issue of obviousness, it is not determinative thereof apart from the three basic inquiries mentioned above. *Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 695 (1965).

Considering, in the first instance, defendants primary claim of invalidity namely invention or obviousness, the Court is directed to the Sixth Circuit pronouncements in *Westwood Chemical, Inc. v. Owens-Corning Fiberglas Corp.*, 445 F.2d 911 (6th Cir. 1971) at page 914 wherein it is stated:

> This Circuit has approached the question of what constitutes "obviousness" through a three-step test prescribing what portions of the question turn on factual determinations and which are purely legal. The first step is "a determination of what the prior art was;

this involves factual questions. Secondly, there is a determination of what, if any, improvement the patentee has made over the prior art; this will usually turn on expert testimony and therefore is a question of fact. The final step is to determine whether the improvement would have been obvious to one skilled in the art. This requires application of a legal criteria and therefore is a question of law, fully reviewable by the appellate court." Monroe Auto Equipment Company v. Heckethorn Manufacturing & Supply Company, *supra*, 332 F. 2d at 411. The Supreme Court has also recognized the factual and legal composition of the question of obviousness. They have stated in Graham v. John Deere Company, 383 U.S. 1, 17, 86 S. Ct. 684, 694, 15 L.Ed. 2d 545 (1965), that:

> "While the ultimate question of patent validity is one of law, Great A. & P. Tea Co v. Supermarket [Equipment] Corp., supra, [340 U.S. 147], at 155, [71 S. Ct. 127, 95 L. Ed. 162], the §103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined."

The earliest evidence of the scope and content of the prior art is demonstrated by the Davia patent for a baseball cap numbered 2,698,434 issued by the United States Patent Office on January 4, 1955, pursuant to application Number 304,615 filed August 15, 1952. (Defendants' Exhibit C). The cap described in the patent is of rigid construction

> . . . being formed of a plastic, or plastic and reinforcing material such as either glass cloth or matted glass fibers impregnated with a polyester resin and cured. Secured to the inside rim of the crown is a resilient foam or sponge rubber band which is relatively thick, i.e., substantially thicker than the walls of the cap. The sponge rubber band is secured in place in various ways, i.e., *cemented in by conventional adhesives available for the purpose.* The liner may be pulled loose and replaced by another when it becomes soiled. (emphasis added)

The patent provides further that:

> The band has several functions. First, it acts to absorb and distribute the force of any blow that is received. Secondly, it enables the cap to cling tightly but comfortably to the player's head, and thirdly, it enables one size of cap to be worn over a range of head sizes and with various head shapes, so that a wide assortment of sizes for either children or adults is not required. (Defendants' Exhibit C)

This design proved unsatisfactory for the reason that the sponge rubber band liner could not be effectively secured in place for any extended period of time. Thus, the lack of an effective adhesive to secure the inner-liner to the plastic cap prompted the industry to explore other methods to provide the necessary protection contemplated by the helmet.

On April 7, 1964, the United States Patent Office issued Patent Number 3, 127,615 to Jackson A. Aileo for a removable rigging for a helmet pursuant to an Application Number 141,866 filed on September 29, 1961. The invention provides in part:

This invention relates to safety helmets and more especially to such helmets having a light rigid shell sufficiently strong to resist bumps or similiar impacts which might injure the head and provided with a rigging for supporting the shell upon the head of a wearer. The invention particularly relates to the rigging and the means for supporting the rigging within the rigid shell.

In the patent to Jackson A. Aileo 2,983,923, issued May 16, 1961 is disclosed a helmet of this type in which the rigging is provided by a head strap of stiffly resilient flexible material, preferably a plastic, this head strap extending in arcuate form over the crown portion of the helmet at the inner surface thereof and carrying at its ends head band elements of arcuate form adapted to extend about the forehead and rear portion of the wearer's head. The head band elements also are of stiffly resilient flexible material and the head strap in its unstressed arcuate form disposes these head bands more closely together than the positions thereof in which the head bands engage the head of the wearer. The head strap is secured to the inner surface of the crown portion of the shell of the helmet and carries at the side thereof toward the head a resilient pad to cushion the crown of the head of the wearer. The fastening means of the helmet of the patent includes screws which are disposed in holes extending through the wall of the shell adjacent the crown portion thereof and engaging nuts which must be removed in order to remove the rigging from the shell.

It is an object of the invention to provide an improved rigging of this type.

It is another object of the invention to provide improved fastening means which is not required to be removed from the shell in order to remove the rigging therefrom.

It is a further object of the invention to provide means for securing the head strap and the head bands supported thereby in place within the shell without utilizing holes through the wall of the shell.

It is a still further object of the invention to provide a rigging in which the resiliently deformable characteristic of the head strap is utilized to effect removal of the rigging from the shell.

It is an additional object of the invention to provide a resiliently deformable head strap capable of cooperating with fastening means permanently secured to the shell for effecting easy removal of the head strap from the shell and reinsertion thereof in the shell.

The purpose of the patent is accomplished, in the words of the patent:

It is a feature of the invention in a helmet provided with a rigging of the general type above described and shown in the Patent No. 2,983,923 to provide *keyhole openings in the head strap that are designed to engage fasteners secured to the inner surface of the shell.* Preferably these keyhole openings are disposed in the portion of the head strap with extends over the inner surface of the crown portion of the the shell of the helmet. The keyhole openings are disposed in spaced relation to each other along the head strap with the slots thereof extending along the head strap. Preferably the slots of the keyhole openings extend toward each other with respect to the enlargements or enlarged portions of the keyhole open-

ings. The keyhole openings, however, may be disposed with the slots thereof extending in the same direction along the head strap, that is, either toward the rear head band element or toward the front head band element respectively supported by and adjacent the ends of the head strap.

In place of the screws extending through the wall of the shell as provided in the helmet of the Patent 2,983,923, in accordance with the present invention fastening elements are provided which are disposed in spaced relation to each other and are secured to the wall of the shell and extend inwardly with respect to the inner surface thereof. In a helmet in which the shell is made of a plastic or similar material capable of thermal softening or fusion, these fastening elements preferably are provided by stud-like elements which are of *material capable of cohesively engaging or fusing with the wall of the shell at the inner surface thereof.* (Defendants' Exhibit F) (emphasis added)

Also available on the market prior to the application for the instant patent was an unpatented helmet manufactured by Tonka (Defendants' Exhibit J). The Tonka design for securing the soft flexible head band to the interior of the molded thermoplastic helmet was essentially the same as the method taught by the Herbert A. Raschke patent Number 3,516,092 and issued June 23, 1970, pursuant to Application Number 683,194 filed on November 15, 1967 (Defendants' Exhibit I) which provides in part as follows:

A suspension harness for a safety hat that has flexible tabs that form the sole connection between the hat and a headband that forms a part of the suspension harness. The tabs include circumferential

appendages that have posts projecting therefrom; the hat shell has holes through which the posts extend, Crown straps that crisscross over the top of the wearer's head are fastened in the hat shell by the posts.

The distinguishing feature of the Raschke and Tonka suspension harnesses is that the *harness* is molded with protruding studs or posts projecting therefrom. The studs are integral to the soft, flexible polyethylene harness. The rigid hat shell is configured with holes there through that have a diameter larger than the base of the posts of the harness, but smaller than the head of such posts so that when the head of the stud is forced through the hole of the helmet the head band firmly is retained in place within the hat.

To further support their claim of invalidity for lack of invention defendants assert that the concept of snap fasteners, friction fasteners and interference fasteners as utilized and applied by the plaintiff herein was a matter of common knowledge and widespread utilization throughout the industry (Defendants' Exhibits D, E, G, H) all of which is basically conceded by the plaintiff who disclaims that such fasteners were used as configured in his patent.

As hereinbefore stated, the issuance of a patent by the United States Patent Office raises a presumption that the patent is valid. That is to say, from the issuance of the Letters Patent, it is presumed that a claimed invention which is "novel" and "useful" amounts to a "discovery or invention" over what was already known in the prior art.

However, this presumption of validity, which amounts to a presumption of invention, extends only to the record before the examiners in the Patent Office. Thus, where

the "file wrapper" of the patent discloses that an earlier patent was considered by the Patent Office during the prosecution of the later application for a patent, it is a presumption that the Patent Office examiner found the existence of differences amounting to invention before the prior art patent so considered and the patent later issued. This presumption does not extend to prior art patents which do not appear from the record "file wrapper" and which had not been considered by the Patent Office in its decision to issue the later patent. Thus, failure of the Patent Office to consider pertinent prior art tends to weaken, if not vitiate, the persumption of validity which attaches to a patent once issued. *Westwood Chemical Inc. v. Owens-Corning Fiberglas Corp., supra.*

This presumption of validity is merely a rule of evidence which places the burden upon one who disputes the validity of a patent to come forward with clear and convincing evidence that the Patent Office acted erroneously in issuing the later patent and failed to distinguish that which was apparent in the "prior state of the art" from that which was shown in the patent here in issue.

Considering in the first instance, the helmet art as disclosed by the Dickstein '864 patent the Court notes significant distinguishing features. Unlike the Raschke or Tonka concept where the protruding studs are integral to the soft flexible suspension harness, the Dickstein '864 patent like the Aileo patent provides for a purality of studs extending inwardly from the *crown of the helmet.* Each of these studs is so positioned and of a size to pass through one of the openings of the *harness* when the harness is snugly assembled inside the helmet in position for use. A significant if not radical departure from the Raschke and Tonka concept.

Comparative analysis of the helmet art apparent from an examination of the Dickstein '864 patent and the Aileo patent again reveals departures or differences as between them.

In the Aileo configuration, the inwardly extending studs of the helmet are of a material capable of *cohesively engaging or fusing* with the *wall of the shell of the helmet* at the inner surface thereof—an adhesive process. The Dickstein '864 patent provides for a purality of inwardly extending studs which are *integral with the crown portion of the helmet*—a moulding process.

Although the physical structure of the studs under both Dickstein and Aileo patents are similar in that each has a shank portion extending transversely from the inner surface of the shell of the helmet and at their inwardly projecting ends, the head portions are of a somewhat larger diametrical dimension than that the diametrical dimension of the shank portions, the Aileo patent provides that the soft flexible plastic head strap is affixed to the shank of the stud by inserting the stud into a keyhole opening provided in the head strap unlike the flexible protective harness of the Dickstein '864 patent which is secured to the inwardly extending studs by cylindrical hollow cups integral to the polyethylene harness the opening diameters of which are smaller than the larger end of the stud extending inwardly from the crown of the helmet. The tip of the stud in the Dickstein '864 patent *is enlarged* to firmly secure the cylindrical hollow cup by the application of heat either through a welding process or while the helmet is still in the mold.

The Aileo patent having been referenced in the "file wrapper" of the Dickstein '864 patent the presumption arises in favor of the later that the Patent Office examiner concluded the existence of differences amounting to inven-

tion between the prior art patent i.e. Aileo and the later issued Dickstein '864 patent

Upon the facts thus presented, the Court finds that the Dickstein '864 patent provided improvement of the helmet art by molding the helmet with inwardly extending studs integral to the crown thereof instead of by adhesives, as well as an improvement in harness art by securing it to the inner lining of the helmet by a method of four friction snaps or interference snaps in the form of cylindrical hollow cups forced over the enlarged end of the stud.

The Court having factually determined the scope of the prior art and the improvement the patentee achieved over the prior art concludes as a matter of law that the Dickstein '864 patent is a combination of old elements assembled, or combined, in such a way as to produce new, advanced and improved results; that is to say, a combination or assembly of old elements which produce a surprising or unusual result, and which would not have been expected by a person having ordinary skill in the pertinent art.

Conversely stated, the Court concludes that the defendants have failed to prove their affirmative defense of obviousness by clear and convincing evidence i.e., that the old elements assembled or brought together, do not combine with one another to produce, in some way or manner, a surprising or unusual result which should be characterized as an "aggregation" of old elements which cannot support a valid patent.

Construing the evidence most favorable on behalf of the defendants, the Court concludes further that the earliest possible date when the Dickstein '864 helmet was available to the public was sometime in April of 1970,

although models may have been available to distributors late in November of 1969. At best an implication may be drawn that the '864 helmets were available in model form late in November of 1969, or 11 months before October 2, 1970, when the application for the '864 patent was filed. Such evidence does not constitute clear and convincing proof that the '864 patent was in public use in this country more than one year prior to the date of plaintiff's patent application contrary to the provisions of Title 35 §102(b) of the United States Code as affirmatively alleged by the defendants.

Considering defendant Boyko's claim that Dickstein did not invent the subject matter of the patent, the Court concludes that absent supporting evidence beyond the bare statement of Boyko to that effect, defendants have failed to overcome, by clear and convincing proof, the presumption of patent validity to '864.

The Court affirmatively concludes from the evidence that patent '864 contains a written description of the invention, and the manner and process of using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains to make use of it and it further sets forth with particularity and distinctly claims the subject matter which the plaintiff Dickstein regarded as his invention.

Absent any proof that plaintiff withheld material facts from the patent office during the prosecution of the application which issued as the patent herein, the Court finds defendants' last claim equally without merit.

Accordingly, the defendants having failed to overcome the presumption of validity attached to the patent clear and convincing evidence, and upon the record in its entirety, the Court concludes that patent '864 is valid.

In order to prove infringement, the plaintiff must prove by a preponderance of the evidence that the product and methods utilized by the defendants embody every essential step of the invention set forth in one or more of the claims of the patent. The product or method must be substantially the same as described in one or more claims of the patent.

Comparing plaintiff's Exhibits 7 and 9, which are representative samples of the defendants' production helmets, available for sale, the Court concludes that they are substantially like those provided for by the '864 patent.

The Court concludes that the period of infringement accrued after notification of the infringement, in this case January 25, 1973, the date the Complaint herein was filed.

IT IS SO ORDERED.

/s/ ROBERT B. KRUPANSKY
United States District Judge

ORDER AMENDING MEMORANDUM, OPINION AND ORDER DATED NOVEMBER 1, 1974

(Filed November 7, 1974)

Civil Action No. C73-79

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

GEORGE DICKSTEIN,
Plaintiff,

SPORTS PRODUCTS CORPORATION,
Party Adverse to Defendants,

vs.

SEVENTY CORPORATION,
GRANTHAM, INC.,
PETER BOYKO,
Defendants.

ORDER AMENDING MEMORANDUM, OPINION AND ORDER DATED NOVEMBER 1, 1974

KRUPANSKY, J.

Pursuant to Rule 60(a), Fed. R. Civ. P., paragraph 3 of page 16 of the Court's Memorandum, Opinion and Order dated November 1, 1974 is hereby amended as follows to reflect Patent Pre-Trial Stipulation No. 7 by and between the parties herein:

Comparing plaintiff's Exhibits 7 and 9, which are representative samples of defendants' Boyko and Seventy Cor-

poration production helmets, available for sale, the Court concludes that they are substantially like those provided for by the '864 patent. Plaintiff's Exhibit 7 is representative of the helmet manufactured by defendant Grantham for defendants Boyko and Seventy.

IT IS SO ORDERED.

/s/ ROBERT B. KRUPANSKY
United States District Judge

OPINION OF THE COURT OF APPEALS

(Filed August 25, 1975)

Nos. 75-1121-2

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

GEORGE DICKSTEIN,
Plaintiff-Appellee,

v.

SEVENTY CORPORATION, ET AL.,
Defendants-Appellants.

GEORGE DICKSTEIN,
Plaintiff-Appellee,

v.

GRANTHAM, INC.,
Defendant-Appellant.

Appeals From the United States District Court
For the Northern District of Ohio.

Before: PHILLIPS, Chief Judge, MCCREE and LIVELY, Circuit Judges.

PHILLIPS, Chief Judge. George Dickstein, owner of U. S. Patent No. 3,711,864, and Sports Products Corporation, of which Dickstein is president, brought this action for infringement against Seventy Corporation, Grantham, Inc., and Peter Boyko. The District Court rejected the

defendants' counterclaim for declaratory judgment of invalidity and held the patent valid and infringed. We reverse the finding of validity and therefore do not reach the issue of infringement.

The Dickstein patent discloses a protective helmet, such as the plastic souvenir baseball helmets which are well known to baseball fans. The principal inventive feature of the helmet is an allegedly novel configuration for joining the interior helmet liner to the helmet shell. Molded on the interior of the helmet are a plurality of generally cylindrical studs. The liner is manufactured with holes corresponding to the placement of studs. The diameter of the holes is slightly smaller than the large end of the stud, and the liner is pressed into place with the studs providing a tight friction fit with the liner. In one disclosed embodiment the studs are manufactured in a cylindrical shape, and then a hot iron is used to expand the end of the stud after the liner has been placed in position. Another embodiment contemplates a "snug, frictional fit" without the subsequent expansion of the end of the stud. Claim 1 of the patent may be read broadly to cover both of these embodiments and requires that "the inner end of each of said studs [is] expanded adjacent the inside of said cup bottom to a size larger than its associated through opening." Claim 3 requires that the stud "pass with friction" through a hole in the liner.

The validity of the Dickstein patent was attacked by the defendants in a counterclaim for declaratory judgment of invalidity. After an extensive review of the prior art, the District Court rejected the contention that the subject matter of the patent would have been obvious to one of ordinary skill in the art under 35 U.S.C. § 103. The District Court stated that:

Upon the facts thus presented, the Court finds that the Dickstein '864 patent provided improvement of the helmet art by molding the helmet with inwardly extending studs integral to the crown thereof instead of by adhesives, as well as an improvement in harness are by securing it to the inner lining of the helmet by a method of four friction snaps or interference snaps in the form of cylindrical hollow cups forced over the enlarged end of the stud.

The Court having factually determined the scope of the prior art and the improvement the patentee achieved over the prior art concludes as a matter of law that the Dickstein '864 patent is a combination of old elements assembled, or combined, in such a way as to produce new, advanced and improved results; that is to say, a combination or assembly of old elements which produce a surprising or unusual result, and which would not have been expected by a person having ordinary skill in the pertinent art.

Conversely stated, the Court concludes that the defendants have failed to prove their affirmative defense of obviousness by clear and convincing evidence, i.e., that the old elements assembled or brought together, do not combine with one another to produce, in some way or manner, a surprising or unusual result which should be characterized as an "aggregation" of old elements which cannot support a valid patent.

Other asserted grounds of invalidity also were rejected.

The District Court required the defendants to "prove their affirmative defense of obviousness by clear and convincing evidence." This quantum of proof was required by this court in *Campbell v. Spectrum Automation Com-*

pany, 513 F.2d 932 (6th Cir. 1975), where evidence as to validity involved oral testimony as to the identity of the inventor. That opinion expressly states that "we do not commit this Circuit to any general rule requiring the application of this standard in all patent cases." 513 F.2d at 937. Our decision in *Campbell* was limited to the factual situation there involved. We expressly reserved a decision "as to when the clear and convincing standard should be applied in other situations involving the statutory presumption of validity." *Id.*

This reservation recently was repeated by this court in *Sperberg v. Goodyear Tire and Rubber Company*, ... F.2d ....., No. 74-2063 (6th Cir. July 3, 1975). In that case we rejected the contention of the patent holder that the trial court should have instructed the jury that "the issuance of the patent was cogent evidence from which a presumption arises, that, by itself, carries [the patent owner's] burden of proof as to validity in the absence of clear and convincing evidence to the contrary." ..... F.2d ..... *Sperberg* further states that the presumption of validity "has no independent evidentiary value, however, but only serves to place the burden of proof on a party who asserts invalidity. *Rains v. Niaqua, Inc.*, 406 F.2d 275, 278 (2d Cir. 1969), *cert. denied*, 395 U.S. 909 (1969)." ..... F.2d ..... Although the District Court in *Sperberg* instructed that invalidity must be proved by clear and convincing evidence, the jury found that the patents in issue were invalid. On appeal, this court found no reversible error in the District Court's instructions and specifically reserved ruling on the proper standard of proof. If the jury found that the evidence of invalidity was clear and convincing, it assuredly would have found that the allegations of invalidity were supported by more than a preponderance of the evidence.

We find no reported decision in this Circuit determining the quantum of proof required on the issue of obviousness. In answering this heretofore unresolved question, we make reference to *Campbell*, which traces the patent presumption of validity from its inception to its present form as codified in 35 U.S.C. § 282. As our discussion of the presumption indicates, *see* 513 F.2d at 935-37, the strict standard is necessary when unusual factual circumstances, by their very nature, require it. Certain testimony may be inherently suspect, as, for example, where oral testimony is offered to prove that the person to whom the patent was issued was not the inventor, or where oral testimony is offered to establish prior public use, *see generally Campbell, supra,* or where there are allegations of fraudulent conduct, *see Schnadig Corp. v. Gaines Mfg. Co., Inc.*, 494 F.2d 383, 392 (6th Cir. 1974) ("Fraud or unclean hands are not to be lightly inferred. They must be established by 'clear, unequivocal and convincing' evidence.") The strict standard of proof in these cases is justified because of the unreliability of hazy and biased recollections of stale facts and circumstances, peculiarly within the knowledge of the testifying parties. These allegations are easy to assert and difficult to rebut. Their character requires a strict standard of proof.

There are no similar circumstances of unreliability in the present case. Patents and other documentary evidence, as well as physical exhibits, were introduced at trial. The parties could have followed (although they did not) the long standing practice of procuring expert testimony on the issue of validity. Nor are there other factors which tend to strengthen the validity of the patent. *See General Tire & Rubber Co. v. Firestone Tire & Rubber Co.*, 489 F.2d 1105, 1116 (6th Cir. 1973), *cert. denied*, 417 U.S. 932 (1974) (prior judicial proceedings); *American*

Home Products Corp. v. Lockwood Mfg. Co., 483 F.2d 1120, 1125 (6th Cir. 1973), *cert. denied*, 414 U.S. 1158 (1974) (prior adjudication of validity); *H. K. Porter, Inc. v. Goodyear Tire & Rubber Co.*, 437 F.2d 244, 246 (6th Cir.), *cert. denied*, 404 U.S. 885 (1971) (Patent Office resolution of interference proceedings); *Panduit Corp. v. Stahlin Bros. Fibre Works, Inc.*, 430 F.2d 221, 225 (6th Cir. 1970) ("protracted proceedings and unusually careful scrutiny" by Patent Office); *see also Westwood Chemical, Inc. v. Molded Fiber Glass Body Co.*, 498 F.2d 1115, 1117 (6th Cir. 1974) other similar claims held invalid in prior proceeding).

We are therefore of the opinion that in this case, and in the usual patent case in which validity is proved with similar evidence, a preponderance of evidence is sufficient to establish invalidity. In this regard we are in agreement with the Second Circuit. *See Rains v. Niagua, Inc.*, 406 F.2d 275, 278 (2d Cir.), *cert. denied*, 395 U.S. 909 (1969) ("a preponderance of evidence determines the issue"); *Lorenz v. F. W. Woolworth Co.*, 305 F.2d 102, 105 (2d Cir. 1962).[1] *See also Reeves Brothers, Inc. v. U. S. Laminating Corp.*, 417 F.2d 869, 872 (2d Cir. 1969) (Kaufman, J.); *Gross v. JFD Manufacturing Co.*, 314 F.2d 196, 198 (2d Cir.) *cert. denied*, 374 U.S. 832 (1963) (Marshall, J.).

Because the District Court erred in applying the clear and convincing evidence standard to the facts of this case, and because invalidity is shown by a preponderance of the evidence, we reverse the District Court's determination of validity and determine that the patent is invalid as a matter of law. We regard obviousness as an ultimate conclusion of law reviewable by an appellate court. *Mon-*

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1. The application of the clear and convincing standard varies among the Circuits. *See Campbell, supra*, 513 F.2d at 937.

roe Auto Equip. Co. v. Heckethorn Mfg. & Supply Co., 332 F.2d 406, 411 (6th Cir. 1964).

At the outset we note that in the present case the record supports the inference that the patent application received only a cursory examination in the Patent Office. The first patent application was allowed on the first office action by the Patent Office, but was abandoned prior to issuance by Dickstein in favor of a continuation application. The continuation was also allowed on the first office action. It does not appear that the Patent Office supplied substantive comments of any nature, in either application, concerning the patentability or unpatentability of the claims. Nor does the record disclose thorough consideration of the prior art by the Patent Office. During the trial, pertinent prior art was introduced in evidence which was not cited by the Patent Office. *See Schnadig Corp. v. Gaines Mfg. Co., Inc.*, 494 F.2d 383, 390-91 (6th Cir. 1974); *Tee-Pak, Inc. v. St. Regis Paper Co.*, 491 F.2d 1193, 1196 (6th Cir. 1974).

The District Court examined each of the patents introduced by the defendants.

In regard to the most pertinent reference, U. S. Patent No. 3,127,615 to Aileo, the Court expressed its opinion that the Dickstein patent could be distinguished on the following basis:

> In the Aileo configuration, the inwardly extending studs of the helmet are of a material capable of *cohesively engaging or fusing* with the *wall of the shell of the helmet* at the inner surface thereof—an adhesive process. The Dickstein '864 patent provides for a plurality of inwardly extending studs which are *integral with the crown portion of the helmet*—a moulding process.

The above-quoted distinction made by the District Court does not support the conclusion that there is a patentable difference. The claims require "studs integral with said crown". Studs which are either adhesively jointed or molded to the crown comprise an assembly which is "[c]omposed of constituent parts making the whole," and therefore "integral". *See* Webster's New Collegiate Dictionary (1961 ed.). Further, the difference between adhesively joining and molding appears in the specification and is not a limitation in the claims. It is well settled that the invention is measured by the claims and not by the specification. *Philips Indus. Inc. v. State Stove & Mfg. Co.*, ... F.2d ....., No. 74-1841 (6th Cir. July 11, 1975); *Minnesota Mining & Mfg. Co. v. Kent Indus., Inc.*, 409 F.2d 99, 101 (6th Cir. 1969); *Kaiser Indus. Corp. v. McLouth Steel Corp.*, 400 F.2d 36, 49 (6th Cir. 1968), *cert. denied*, 393 U.S. 1119 (1969).

The District Court further noted that Aileo and Dickstein were alike except for a minor variation in the shape of the hole through which the stud was inserted:

> the Dickstein '864 patent like the Aileo patent provides for a plurality of studs extending inwardly from the *crown of the helmet*. Each of these studs is so positioned and of a size to pass through one of the openings of the *harness* when the harness is snugly assembled inside the helmet in position for use.
>
> . . . .
>
> Although the physical structure of the studs under both Dickstein and Aileo patents are similar in that each has a shank portion extending transversely from the inner surface of the shell of the helmet and at their inwardly projecting ends, the head portions are of a somewhat larger diametrical dimension than that

> the diametrical dimension of the shank portions, the Aileo patent provides that the soft flexible plastic head strap is affixed to the shank of the stud by inserting the stud into a keyhole opening provided in the head strap unlike the flexible protective harness of the Dickstein '864 patent which is secured to the inwardly extending studs by cylindrical hollow cups integral to the polyethylene harness the opening diameters of which are smaller than the larger end of the stud extending inwardly from the crown of the helmet. The tip of the stud in the Dickstein '864 patent *is enlarged* to firmly secure the cylindrical hollow cup by the application of heat either through a welding process or while the helmet is still in the mold.

Looking to the claims in the Dickstein patent, it is apparent that they do nothing more than call for "a through opening . . . of a diameter smaller than the inside diameter of said cup", with the cup "generally cylindrical" and opening inwardly". The keyhole configuration in Aileo is arguably close to this feature, since we are not required to find exactly the identical feature, but rather look for what is obvious to one of ordinary skill in the art. However, this feature is contained in two other references. U.S. Patent No. 3,516,092 to Raschke and an unpatented helmet made by another manufacturer show the exact configuration, but with the parts reversed. The holes are in the helmet and the studs are on the liner. The District Court made the following statement with respect to these references:

> The distinguishing feature . . . is that the *harness* is molded with protruding studs or posts projecting therefrom. The studs are integral to the soft, flexible polyethylene harness. The rigid hat shell is configured

> with holes there-through that have a diameter larger than the base of the posts of the harness, but smaller than the head of such posts so that when the head of the stud is forced through the hole of the helmet the head band firmly is retained in place within the hat.

The snap fastening or friction fit of a plastic stud with an associated opening is thus clear from these references. In addition, the defendants cited other patents and produced samples of snap fit and interference fit plastic parts which show that the concept is old per se. Therefore, the factual distinction noted by the District Court is without a legal difference. These references are both "teaching references" in the purest sense, and cure the deficiencies of Aileo. A person of ordinary skill in the art would be able to use this disclosure of the "through opening" with the otherwise complete disclosure of Aileo to produce a device as claimed.

Since each of the claim elements is present in the prior art, this case is brought within the rule recently reiterated in *Philips Industries, Inc. v. State Stove & Mfg. Co., supra,* ..... F.2d ....., where we stated:

> Given that the individual claim elements are old and disclosed in the prior art, if this device is to be patentable then there must be that "impalpable something," *Harvey v. Levine,* 322 F.2d 481, 485 (6th Cir. 1963), in the combination itself that would render the invention unobvious. The Supreme Court decisions require that patents for the combination of old elements receive special scrutiny "with a care proportioned to the difficulty and inprobability of finding invention in an assembly of old elements." *Great Atlantic and Pacific Tea Co. v. Supermarket Equip.*

Corp., 340 U.S. 147, 152 (1950). The concept of "synergistic result," which is "when the whole in some way exceeds the sum of its parts," has evolved to determine what constitutes the "key requirement," of patentability. *Anderson's-Black Rock v. Pavement Salvage Co., Inc.*, 396 U.S. 57, 60-61 (1969); *Great Atlantic & Pacific Tea Co., supra*, 340 U.S. at 152.

The conclusion of the District Court that there are any such unusual or surprising results in the Dickstein helmet is not supported by the record. As we said in *Philips Industries, supra*, ... F.2d at .....:

> Each element operates as well separately as it does in combination, and as in *Anderson's-Black Rock, supra*, 396 U.S. at 60, the combination "though perhaps a matter of great convenience, did not produce a 'new or different function,' *Lincoln Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549, within the test of validity of combination patents."

The Dickstein patent is therefore invalid as obvious to one of ordinary skill in the art under the provisions of 35 U.S.C. § 103.

Since the patent is invalid, it is unnecessary to reach the other issues of validity or infringement.

Reversed.

Costs are taxed against plaintiff-appellee.

JUDGMENT ENTRY OF THE COURT OF APPEALS

(Dated August 25, 1975)

Case Nos. 75-1121 and 75-1122

UNITED STATES COURT OF APPEALS

FOR THE SIXTH CIRCUIT

GEORGE DICKSTEIN,
Plaintiff-Appellee,

v.

SEVENTY CORPORATION, ET AL.,
Defendants-Appellants.

GEORGE DICKSTEIN,
Plaintiff-Appellee,

v.

GRANTHAM, INC.,
Defendant-Appellant.

JUDGMENT

APPEAL from the United States District Court for the Northern District of Ohio.

This cause came on to be heard on the record from the United States District Court for the Northern District of Ohio, and was argued by counsel.

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the Judgment of the said District Court in this cause be and the same is hereby reversed.

It is further ordered that the defendants-appellants recover from the plaintiff-appellee the cost of appeal, as

itemized below, and that an execution therefor issue out of said District Court if necessary.

ENTERED BY ORDER OF THE COURT.

JOHN P. HEHMAN
Clerk

SUPREME COURT, U. S.

FILED

DEC 8 1975

MICHAEL RODAK, JR., CLERK

Supreme Court of the United States

October Term, 1975

No. 75-697

GEORGE DICKSTEIN and SPORTS PRODUCTS CORPORATION,

Petitioners,

vs.

SEVENTY CORPORATION, PETER BOYKO and GRANTHAM, INC.

Respondents.

BRIEF OF RESPONDENT GRANTHAM, INC. IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI To the United States Court of Appeals For the Sixth Circuit

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Supreme Court of the United States

October Term, 1975
No. 75-697

GEORGE DICKSTEIN and SPORTS PRODUCTS CORPORATION,

Petitioners,

vs.

SEVENTY CORPORATION, PETER BOYKO and GRANTHAM, INC.,

Respondents.

BRIEF OF RESPONDENT GRANTHAM, INC. IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

Respondent Grantham, Inc. ("Grantham") submits the within Brief in Opposition to the Petition of George Dickstein and Sports Products Corporation for the issuance of a Writ of Certiorari from this Court to the United States Court of Appeals for the Sixth Circuit. As more fully set forth below, the Petition for Writ of Certiorari (the "Petition") does not present any special or compelling reasons for the issuance of the requested Writ.

I. **ARGUMENT IN OPPOSITION TO THE PETITIONERS' FIRST QUESTION: In its holding with respect to the quantum of proof necessary for Respondents to establish their defense of "obviousness" in this patent infringement case, the decision of the Court of Appeals harmonizes with the express mandate of the United States Supreme Court and does not commit the Sixth Circuit to a rigid standard in conflict with the other Federal Courts of Appeals.**

In reliance upon the Supreme Court's decision in *Radio Corporation of America v. Radio Engineering Laboratories, Inc.*, 293 U.S. 1 (1934), Petitioners maintain that the Court of Appeals has ignored the express mandate of this Court by holding that the appropriate evidentiary burden to impose upon Respondents in regard to their "obviousness" defense to this patent infringement case (Patent Act, 35 U.S.C. § 103 (1952)) is "a preponderance of the evidence." However, as evidenced by the following excerpt from its decisions in *Campbell v. Spectrum Automation Company*, 513 F.2d 932 (6th Cir. 1975), the Sixth Circuit has demonstrated a sensitive awareness to Supreme Court pronouncements in this area, concluding that the "clear and convincing" standard for proving the invalidity of a patent has been confined by the Supreme Court to cases involving virtually exclusive reliance upon oral testimony:

> "Section 282 requires that: 'A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.' . . . Even though this presumption makes patentees 'heavily favored as a class of litigants,' *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313, 335, 91 S. Ct. 1434, 1446, 28 L.Ed. 2d 788 (1971), it leaves unspecified the quantum of proof necessary to meet the 'burden of establishing invalidity.'
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> "The Supreme Court first commented on the presumption of validity in *Coffin v. Ogden*, 85 U.S. (19 Wall.) 120, 124, 21 L.Ed. 821 (1873), stating that 'every reasonable doubt' should be resolved against the party asserting invalidity. Oral testimony of unpatented prior art was found in that case to defeat the patent. The Supreme Court emphasized that the unreliability of such oral testimony 'bring[s] the case made by the appellees within the severest legal tests which can be applied . . . .' *Id.* at 125. Subsequently *Cantrell v. Wallick*, 117 U.S. 689, 6 S.Ct. 970, 29 L. Ed. 1017 (1886) involved a contention of prior use sought

to be proven by oral testimony. The Court again held that 'every reasonable doubt' should be resolved against the party asserting invalidity. *Id.* at 696, 6 S. Ct. 970. In *The Barbed Wire Patent*, 143 U.S. 275, 284, 12 S. Ct. 443, 447, 36 L.Ed. 154 (1891), . . . [t]he rationale for this strict standard was explained as follows:

> 'We have now to deal with certain unpatented devices, claimed to be complete anticipations of this patent, the existence and use of which are proven only by oral testimony. In view of the unsatisfactory character of such testimony, arising from the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury, courts have not only imposed upon defendants the burden of proving such devices, but have required that the proof shall be clear, satisfactory and beyond a reasonable doubt. Witnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves are not usually to be depended upon for accurate information.'
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> . . . .
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> "The source of the 'clear and convincing' standard springs from these early decisions, wary of the dangers of accepting parol evidence exclusively to prove facts which are established more reliably by documentary evidence. . . .
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> "These earlier Supreme Court cases seem to have confined this strict standard to those cases where a prior use was undertaken to be proved by oral testimony." 513 F.2d at 935-36.

Moreover, subsequent to its decision in *Radio Corporation of America v. Radio Engineering Laboratories, Inc.*, cited *supra*, the U.S. Supreme Court in *Williams Mfg. Co. v. United Shoe Mach. Corp.*, 316 U.S. 364 (1942), criticized

and rejected the Sixth Circuit's adherence to the strict standard utilized in *Radio Corporation of America,* stating that special circumstances affect the weight to be accorded the presumption of validity and that the presumption serves only to resolve in favor of the patentee an instance of evidentiary equilibrium:

> "Whatever the small weight to be given to the presumption arising from issuance of a patent, it is here overcome by the special circumstances of this case. . . . At the very best, the presumption of validity arising from the mere issuance of a patent might be permitted to tip the scale when other considerations leave the issue of patentability in equilibrium." 316 U.S. at 393.

More recently, the Supreme Court has advocated a flexible, case-by-case approach to the question of "obviousness" in patent infringement cases:

> "This is not to say, however, that there will not be difficulties in applying the nonobviousness test. *What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however,* are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and *should be amenable to a case-by-case development." Graham v. John Deere Co.*, 383 U.S. 1, 18 (1966) (emphasis added).

In applying the "preponderance" standard to this case, the Court of Appeals noted the "special circumstances" which rendered this standard appropriate: the Respondents sought to prove their defense of "obviousness" by prior patents, other documentary evidence and physical exhibits; conversely, unlike cases involving "prior use" claims and challenges to the patentee's inventorship, this case was not characterized by "the unreliability of hazy and biased recollections of stale facts and circumstances, peculiarly within the knowledge of the testifying parties." (Opinion of the

Court of Appeals, set forth in the Petition for Writ of Certiorari at 25A).

The Court of Appeals' adoption of the "preponderance" standard as opposed to the stricter standard of "clear and convincing evidence" is also entirely consonant with this Court's mandate that:

> "Courts should scrutinize combination patent claims [such as the one at bar] with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements." *Great A. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 152 (1950).

In brief, the Court of Appeals' application of the "preponderance" standard in the case at bar does not in any manner contravene Supreme Court mandates. *See, e.g., Graham v. John Deere Co., Great A. & P. Tea Co. v. Supermarket Equip. Corp.* and *Williams Mfg. Co. v. United Shoe Mach. Corp.*, all cited *supra;* nor does it present a special or compelling rationale for granting *certiorari*, for this Court has consistently left undisturbed appellate decisions which have applied the "preponderance" standard. *See, e.g., Rains v. Niaqua, Inc.*, 406 F.2d 275 (2nd Cir.), *cert. denied*, 395 U.S. 909 (1969); *Gross v. JFD Manufacturing Co., Inc.*, 314 F.2d 196 (2nd Cir.), *cert. denied*, 374 U.S. 832 (1963).

Furthermore, the Sixth Circuit has not committed itself to a rigid "preponderance" standard in direct conflict with the positions adopted in other Federal Circuits. As recently as its April 17, 1975 decision in *Campbell v. Spectrum Automation Company*, cited *supra*, the Sixth Circuit, noting the heavy reliance of the alleged infringer in that case upon stale, biased and uncorroborated oral evidence peculiarly within his knowledge, held that the defendant, who assailed the identity of the patentee as the true inventor (Patent Act, 35 U.S.C. § 102(f) (1952)), was required to prove

his defense by "clear and convincing" evidence. The Court in *Campbell,* however, expressly limited the scope of its holding:

> "We conclude that the clear and convincing standard should be applied in the present case. In doing so, we do not commit this Circuit to any general rule requiring the application of this standard in all patent cases.
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> ". . . Our decision is confined to the factual situation presented in the case at bar. We expressly reserve a decision as to when the clear and convincing standard should be applied in other situations involving the statutory presumption of validity." 513 F.2d at 937.

Thereupon, consistent with the Supreme Court mandate that special circumstances be taken into account in determining the weight to be accorded the statutory presumption of validity, the Sixth Circuit in the decision below held that in view of the special quality of the evidence adduced by Respondents to establish the defense of "obviousness", the lesser standard of proof was warranted:

> "There are no similar circumstances of unreliability in the present case. Patents and other documentary evidence, as well as physical exhibits, were introduced at trial. . . . Nor are there other factors which tend to strengthen the validity of the patent.
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> . . .
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> "We are therefore of the opinion that *in this case, and in the usual patent case in which validity is proved with similar evidence,* a preponderence of evidence is sufficient to establish invalidity." Opinion of the Court of Appeals, set forth in the Petition for Writ of Certiorari at 25A-26A (emphasis added).

Rather than adopting, as Petitioners charge, a rigid standard in conflict with other Circuits, the Sixth Circuit

has exercised the very flexibility and case-by-case approach counseled by the U.S. Supreme Court.

Finally, there is an additional factor present in the case at bar which further serves to justify the application of the "preponderance" standard and dissipate the alleged conflict between the decision below and those in other Federal Circuits. The Court of Appeals noted that, "During the trial, pertinent prior art was introduced in evidence which was not cited by the Patent Office." (Opinion of the Court of Appeals, set forth in the Petition for Writ of Certiorari at 27A.) The Sixth Circuit has consistently held that since the statutory presumption of validity is grounded upon the deference to be accorded to the expertise of the Patent Office, the failure of that Office to consider pertinent prior art tends to weaken, if not destroy, the presumption. *Westwood Chemical, Inc. v. Owens-Corning Fiberglas Corporation*, 445 F.2d 911 (6th Cir. 1971), *cert. denied*, 405 U.S. 917 (1972); *The B. F. Goodrich Company v. Rubber Latex Products, Inc.*, 400 F.2d 401 (6th Cir. 1968); *Royal Patent Corp. v. Monarch Tool & Mfg. Co.*, 203 F.2d 299 (6th Cir. 1953).

Moreover, the principle of the weakened presumption of validity (and, accordingly, a less strict standard of evidence for overcoming the presumption) has been adopted in other Federal Circuits, *including Circuits such as the Fifth and Seventh which require that an unweakened presumption be overcome by "clear and convincing" evidence. See, e.g., Stamicarbon, N.V. v. Escambia Chemical Corporation*, 430 F.2d 920 (5th Cir.), *cert. denied*, 400 U.S. 944 (1970); *Deep Welding, Inc. v. Sciaky Bros., Inc.*, 417 F.2d 1227 (7th Cir. 1969), *cert. denied*, 397 U.S. 1037 (1970).

II. ARGUMENT IN OPPOSITION TO THE PETITIONERS' SECOND QUESTION: Not only does the record contain extensive oral testimony from "one skilled in the art", but also, even in the absence of

such testimony, the District Court is charged by law with determining (and the Court of Appeals with reviewing) the issue of whether or not the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of invention to a person having ordinary skill in the art.

As their second ground for the issuance of a Writ of Certiorari, Petitioners charge that in the absence of any testimony from "one skilled in the art", the Court of Appeals improperly interjected itself into the record in determining that the alleged invention *would* have been obvious to one skilled in the relevant art.

In the first instance, Petitioners' characterization of the testimony in the record is inaccurate: Respondents established the credentials of John P. Grantham as a person skilled in the relevant art and proceeded to elicit extensive testimony from him as to the similarities between Petitioners' alleged invention and the objects and patents which constituted the prior art (R. 161-86); thus, the record is not, as Petitioners suggest, devoid of testimony from "one skilled in the art".

Moreover, even if the record were barren of such testimony, there were, as noted by the Court of Appeals, "[p]atents and other documentary evidence, as well as physical exhibits" (Opinion of the Court of Appeals, set forth in the Petition for Writ of Certiorari at 25A) from which to conclude that the Dickstein patent did not achieve any results which would not have been obvious to one of ordinary skill in the art. Petitioners cite no authority that an alleged infringer who asserts the defense of "obviousness" *must* produce oral testimony from one skilled in the art; in fact, there is judicial recognition that the language in 35 U.S.C. § 103 refers to a "*fictional* or *theoretical* 'person having ordinary skill in the art.'" *Lorenz v. F. W. Wool-*

worth Co., 305 F.2d 102, 106 (2nd Cir. 1962) (dissenting opinion) (emphasis added).

The Court of Appeals did not improperly inject itself into the record but rather drew a *legal* conclusion which it is charged with making. *Graham v. John Deere Co.*, cited *supra*. The determination of "obviousness" requires first a determination of the state of the prior art and secondly a determination of the improvement, if any, which the patentee has achieved over the art; thereafter,

> "The final step is to determine whether the improvement would have been obvious to one skilled in the art. *This requires application of a legal criteria and therefore is a question of law, fully reviewable by the appellate court." Monroe Auto Equipment Company v. Heckethorn Manufacturing & Supply Company*, 332 F.2d 406, 411 (6th Cir.), *cert. denied*, 379 U.S. 888 (1964) (emphasis added).

Surely Petitioners do not maintain that in the absence of expert testimony from one skilled in the relevant art, the District and Appellate Courts should abstain from determining the legal issue of "obviousness". Indeed, Petitioners had no difficulty with the District Court interjecting *itself* and concluding that the patentee's invention was *not* obvious.

III. ARGUMENT IN OPPOSITION TO THE PETITIONERS' THIRD QUESTION: The Court of Appeals was wholly justified in inferring that the patent application received only a cursory examination in the Patent Office.

By virtue of the convenient deletion of a critical excerpt from the Court of Appeals decision, Petitioners suggest that the inference of a cursory examination by the Patent Office of the patent in suit was based solely on the fact that the patent was allowed as filed without any substantive comments. A more complete quotation from the

Court of Appeals decision discloses its *reliance on the fact that pertinent prior art was not cited by the Patent Office:*

> "At the outset we note that in the present case the record supports the inference that the patent application received only a cursory examination in the Patent Office. The first patent application was allowed on the first office action by the Patent Office, but was abandoned prior to issuance by Dickstein in favor of a continuation application. The continuation was also allowed on the first office action. It does not appear that the Patent Office supplied substantive comments of any nature, in either application, concerning the patentability or unpatentability of the claims. *Nor does the record disclose thorough consideration of the prior art by the Patent Office. During the trial, pertinent prior art was introduced in evidence which was not cited by the Patent Office. See Schnadig Corp. v. Gaines Mfg. Co., Inc.*, 494 F.2d 383, 390-391 (6th Cir. 1974); *Tee-Pak, Inc. v. St. Regis Paper Co.*, 491 F.2d 1193, 1196 (6th Cir. 1974)." Opinion of the Court of Appeals, set forth in the Petition for Writ of Certiorari at 27A (emphasis added).

The failure of the Patent Office to consider relevant prior art has always been a factor of significance in determining the validity of a patent in suit; as noted above, such failure tends to weaken, if not destroy, the statutory presumption of validity. *See, e.g., Westwood Chemical, Inc., v. Owens-Corning Fiberglas Corporation*, cited *supra*. This weakening of the presumption is itself based upon the very reasoning adopted by the Court of Appeals, *i.e.*, that the failure of the Patent Office to cite and consider relevant prior art is indicative of an imperfect examination of the patent in question, thereby negating the rationale for according the statutory presumption in the first place.

CONCLUSION

Since Petitioners have failed to present any special or compelling reasons for review of the Court of Appeals

decision, the request for a Writ of Certiorari should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned counsel, a member of the bar of the United States Supreme Court, hereby certifies that, in compliance with Rule 33 of the Supreme Court Rules, three (3) printed copies of the foregoing Brief of Respondent Grantham, Inc. in Opposition to the Petition for Writ of Certiorari were deposited in the United States mail on this 9th day of December, 1975, with first class postage prepaid, addressed to each of Richard J. Egan of the law firm Baldwin, Egan, Walling & Fetzer, 1430 Keith Building, Cleveland, Ohio 44115 and Milton H. Wyner of the law firm Wyner and Wyner, 2312 Terminal Tower, Cleveland, Ohio 44113, co-counsel of record for Petitioners George Dickstein and Sports Products Corporation, and William C. McCoy, Jr., of the law firm Bosworth, Sessions & McCoy, 625 National City Bank Building, Cleveland, Ohio 44114, counsel of record for Respondents Seventy Corporation and Peter Boyko.

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